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TO: Examiner: Z. N. Davis
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NOTES/COMMENTS:


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In re Application of: B. Shankar *et al*
For Patent entitled: "Cannabinoid Receptor Ligands"
Group Art Unit: 1625
Filed: 03/18/2004
Attorney Docket No.: IN06009US01
Serial No.: 10/803,577

Dear Examiner Davis

Transmitted herewith are:

- Fax Cover Sheet – 1pg.
- Cert. of Transmission – 1pg.
- Response Transmittal – 1pg.
- Response to Restriction Requirement – 3pgs.


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Docket Number: IN06009US01
Application No: 10/803,577
Filing Date: 03/18/2004
First Inventor: SHANKAR, Bandarpalle B.

PTO/SB/97 (08-04)
Approved for use through 07/31/2008. OMB 0851-0031
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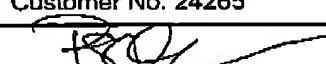
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TRANSMITTAL FORM <i>(to be used for all correspondence after initial filing)</i>	Application Number	10/803,577
	Filing Date	03/18/2004
	First Named Inventor	SHANKAR, Bandarpalle B.
	Art Unit	1625
	Examiner Name	Z. N. Davis
	Attorney Docket Number	IN06009US01
Total Number of Pages In This Submission		6

ENCLOSURES (Check all that apply)		
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PATENT CASE: IN06009US01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

B. Shankar et al

Examiner: Z. N. Davis

Application No.: 10/803,577

Group Art Unit: 1625

Filed: 03/18/2004

For: **"Cannabinoid Receptor Ligands"**

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

Sir:

This communication is in response to the Office Action issued on May 4, 2006 in the subject case. This communication is being faxed to the Examiner's attention at 571-273-8300.

Claims 1-57 are pending in the case. The Examiner restricted the invention into seven groups:

Group I: Claims 1-23, 30 and 31, drawn to a compound, a pharmaceutical composition and process to make the compound, according to formula I;

Group II: Claims 24-29, drawn to a method of treating diseases using a compound of formula I;

Group III: Claims 32-39 drawn to a pharmaceutical composition and method of treating rheumatoid arthritis using a compound of formula I;

Group IV: Claims 40-43, drawn to a pharmaceutical composition and a method for treating multiple sclerosis using a compound of formula I;

Group V: Claims 44-51, drawn to a pharmaceutical composition and a method for treating rheumatoid arthritis using a compound of formula I;

Group VI: Claims 52-57, drawn to a pharmaceutical composition and method of treating seasonal allergic rhinitis using a compound of formula I; and

Group VII: Claims 52-57, drawn to a pharmaceutical composition and method of treating asthma using a compound of formula I;

If electing a compound group from among Groups I-VII, the Examiner additionally required the election of a single disclosed species for prosecution on the merits.

Applicants believe that all claims 1-57 form part of one and the same invention. Applicants further believe that when there is a linking claim (claim 1 here) encompassing the scope of all the processes, uses, composition and compounds, it is inappropriate to restrict the invention into these various inventions. Applicants also believe that due to such commonality, a complete examination of claims 1-57 as filed would not cause undue burden. Applicants further believe that the same art search will most probably apply to the alleged separate inventions, and respectfully submit that the restriction is improper.

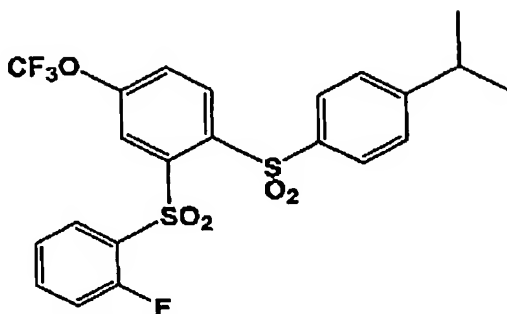
Under the statute "two or more independent and distinct inventions.... in one application may.... be restricted to one of the inventions." Inventions are "independent" if "there is no disclosed relationship between two or more subjects disclosed" (MPEP 802.01). The term "distinct" means that "two or more subjects as disclosed are related.... but are capable of separate manufacture, use or sale as claimed, and are patentable over each other" (MPEP 802.01). However, even when patentably distinct inventions, restriction is not required unless one of the following reasons appear (MPEP 808.02):

1. Separate classification
2. Separate status in the art; or
3. Different field of search.

In the present application, Applicant believes that the Examiner has not established a clear reason to establish the existence of any of the above 3 groups. Reconsideration and withdrawal of the restriction requirement are, therefore, respectfully requested.

However, in the interest of advancing the prosecution, Applicants elect, with traverse, the invention cited as Group I for prosecution on the merits, and elect, again with traverse, the following species:

3



This compound is included in Claim 17 and is also identified in the scheme on page 43 as Compound 12C. All claims of the elected group read on this compound.

Applicants note with appreciation that the Examiner has indicated rejoinder of process claims that depend from or otherwise include all the limitations of the patentable product as a matter of right.

If the Examiner has questions, the Examiner is invited to contact the undersigned.

May 30, 2006
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Respectfully submitted,

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